

Remarks / Arguments:

Claims 7-16 are pending in the application. Claims 7-16 have been rejected. The applicant respectfully traverses these rejections, as discussed in more detail below.

Rejections under 35 U.S.C. § 101

The Office Action rejects claims 7, 9, 13, and 16 as directed toward non-statutory subject matter, specifically because the claims positively recite portions of the body, namely lumens having certain characteristics. The applicant respectfully traverses this rejection, but has amended the claims to clarify that the device "is sized to be deployed in" lumens having the recited characteristics. Accordingly, the applicant respectfully submits that this rejection should be withdrawn.

Rejections based upon Kugler et al.

The Office Action rejects claims 7-16 as anticipated by, or in the alternative, as obvious over Kugler et al. (U.S. Patent No. 6,129,756, hereinafter "Kugler"). The Office Action states that Kugler "shows a flared transition from the second diameter to the third diameter" and further adds that "because the point of inflection will not be an exact 90 degrees, the flared transition is inherently curved, thus concave and trumpet shaped." The applicant respectfully traverses this rejection and respectfully disagrees with the statement that a point of inflection that is not an exact 90 degrees is inherently concave and trumpet shaped. As disclosed by the applicant, the transition between diameters may be conical (as shown in Fig. 5) or trumpet-shaped (as shown in Fig. 4). Kugler makes no mention of the actual shape of the transition, and the figures do not specifically show a trumpet-shaped transition as defined by the applicant. If anything, the transition shown in the figures in Kugler is depicted as a conical transition between diameters, not a trumpet-shaped one.

The Office Action further states, in the alternative, that "because the applicant teaches use of flared transitional portions . . . being either conical (Fig. 5) or concave trumpet-shaped (Fig. 4) and the applicant has not disclosed an advantage for a concave flare versus a conical flare, it would have been an obvious matter of design choice to have a concave transitional portion, which would perform equally as well as the conical transition portion." Again, Applicant respectfully traverses this rejection and disagrees with the statements in the Office Action. One advantage of a trumpet shaped configuration over a conical configuration is that the transition in diameter can be made over a shorter length with a trumpet-shaped configuration as compared to a conical configuration. Accordingly, the two configurations are not equal, given this disclosed advantage. The trumpet-shaped portion may have particular advantages for use, for example, in an indication comprising a narrow distal aorta and short and dilated iliac arteries.

An "obvious design choice" rejection is precluded where the claimed structure and the function it performs are different from the prior art. *In re Gal*, 25 USPQ2d 1076 (Fed. Cir. 1992). In making its rejection based upon Kugler, the Office Action has failed to cite any prior art that teaches or suggests use of a trumpet-shaped transition portion. Only the applicant has disclosed this structure and its advantages. There is no requirement that the advantages of particular structures be disclosed in the specification. *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995) ("obviousness is determined by the totality of the record including, in some instances

most significantly, the evidence and arguments proffered during the give-and-take of ex parte patent prosecution"). Thus, the applicant's claimed structure and function are clearly different from Kugler, which fails to show the structure or function at all. The applicant further notes that the structure and function shown by Strecker, cited by the Office Action only in combination with Martin, are also different than the applicant's structure and function, as detailed further below.

Rejections based upon Martin and Strecker

The Office Action rejects claims 7-9 and 11-16 under 35 U.S.C. 103(a) as unpatentable over Martin (U.S. Pat. No. 5,575,817) in view of Strecker (U.S. Pat. No. 5,405,378). The Office action cites Martin as showing a transition portion from a tubular limb to a distal end having an increase in diameter, and cites Strecker as teaching the use of trumpet-shaped ends on a device used near branch vessels for the purpose of preventing slippage. Applicant respectfully traverses this rejection. The portion of Strecker cited by the Office Action, col. 6, lines 1-10, appears to be the only discussion of trumpet-shaped ends within Strecker. This discussion in its entirety, reads:

Finally, according to yet another improvement, the prosthesis, kept in the radially compressed position by the strippable sheath, can expand to resemble a trumpet at its proximal end in the expanded state following removal of the sheath. This prosthesis design is important for implants in the vicinity of branches in the vessels, because there is always the danger of the prosthesis slipping into the branching vessel. In view of the trumpet-shaped expansion at the proximal end, however, such slipping during implantation is effectively suppressed when the sheath surrounding the prosthesis is stripped off the proximal end.

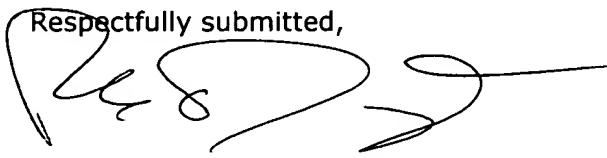
The above paragraph makes clear that Strecker does not teach or suggest a prosthesis with branches for deployment within branch lumen, but rather teaches a prosthesis that is unbranched and that is designed to be kept from slipping into the branch lumen. By teaching that a trumpet-shaped structure can be used to keep a prosthesis out of a branch lumen, Strecker teaches away from the applicant's invention, which specifically claims a trumpet-shaped transition portion leading to an end to be deployed *within* a branch lumen.

Furthermore, Strecker provides no drawing or further disclosure from which it can be determined what is meant by the prosthesis expanding "to resemble a trumpet at its proximal end." Furthermore, a structure resembling a trumpet at its *proximal end* is not the same as a structure having a trumpet-shaped *transition portion*. Applicant's claims recite a distal end having a third diameter, where the trumpet-shaped portion is located between a second, smaller diameter portion and the third, larger diameter portion. Thus, there can be no motivation or suggestion to combine Martin with Strecker (1) because Strecker teaches away from deployment of the prosthesis within branch lumen, and (2) because Strecker does not provide enough information from which one can determine what is meant by the disclosure. Furthermore, even if the references are combined, the resulting structure still fails to teach or suggest the applicant's claimed invention, which comprises a trumpet-shaped *transition portion*, not a trumpet-shaped *end*. Thus, the structure and function of the end disclosed by Strecker is completely different than the applicant's claimed invention.

Conclusions

For all of the above reasons, the rejections under 35 U.S.C. §§ 101, 102, and 103 should all be withdrawn. Favorable action is earnestly solicited. The Examiner is invited to call the applicants' undersigned representative if any further amendment will expedite the prosecution of the application or if the Examiner has any suggestions or questions concerning the application or the present Response. In fact, if the claims of the application are not believed to be in full condition for allowance, for any reason, the applicants respectfully request the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP § 707.07(j) or in making constructive suggestions pursuant to MPEP § 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,



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